

### **REMARKS**

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested. No claims are amended. Applicants appreciate the interview with the Examiner and his supervisor on December 20, 2006 and the courtesy that was extended.

#### **Rejection of Claims 5, 7, 20, 28 and 29 Under 35 U.S.C. §103(a)**

The Office Action rejects claims 5, 7, 20, 28 and 29 under 35 U.S.C. §103(a) as being unpatentable over 3Com Corporation (Handbook for the Palm V Organizer, 1999) ("3Com®") in view of Derocher (U.S. Patent No. 6,822,640) ("Derocher") and Kobayashi (U.S. Publication No. 2001/0044319) ("Kobayashi"). Applicants respectfully traverse this rejection and submit that one of skill in the art would not have sufficient motivation or suggestion to combine these references.

To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some motivation or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to combine the references. Second, there must be a reasonable expectation of success, and finally, the prior art references must teach or suggest all the claim limitations. The Examiner bears the initial burden of providing some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 2142.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not

sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP 2143.01.

Furthermore, if the examiner determines there is factual support for rejecting the claimed invention under 35 U.S.C. 103, the examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of "a preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it. With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not. MPEP 2142.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991). MPEP 2143.01.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). MPEP 2142.01 (emphasis in original).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

With these principles in mind, Applicants respectfully submit that one of skill in the art would not by preponderance of the evidence have sufficient motivation or suggestion to combine these references. These references were discussed in the interview, Applicants provide a summary of the argument for further consideration by the Examiner.

Applicants provide in the enclosed Information Disclosure Statement the reference showed to the Examiner in the interview which is 3Com Corporation, Handbook for the Palm V Organizer, 1999 wherein after “3Com®2”. The basic disclosure teaching and suggestive power of 3Com® and 3Com®2 are similar in that 3Com®2 is merely a different version of the Palm V Handbook. However, Applicants has provided 3Com®2 to highlight more details about one of skill in the art would understand by way of the suggestive power of the 3Com® references and what they teach relative to the potential combination with other references such as Derocher.

For example, Applicants note that page 14 of 3Com®2 discusses the tapping and typing methods for interacting with the Palm V Organizer. For example, it states that like using a mouse to click on a computer screen, using the stylus to tap elements on your organizer screen is the basic action that gets things done on your organizer. Applicants also note that page 14 of 3Com®2 includes an “important” comment which states as follows: “Important: Always use the point of the stylus for tapping or making strokes on the organizer screen. Never use an actual pen, pencil, or other sharp object to write on the organizer screen.” Applicants note that this portion, as well as Chapter 2, which starts on page 25 of 3Com®2, discuss further conveniences of entering data into the Palm V Organizer with the stylus. The graffiti characters are introduced and the user is taught how to input the graffiti letters into the graffiti writing area using the

stylus. The graffiti alphabet is taught, as well as how to use graffiti number and graffiti punctuation marks and other characters. In sum, Applicants respectfully submit that it is clear throughout the teachings of 3Com® and 3Com®2 that one of skill in the art would recognize that the explicit teachings of these references require the user to interact with the Palm device through using a stylus in the graffiti writing area. Accompanying this teaching is the fact that one of skill would recognize that because of the precision required for using the stylus a person would be unsuccessful at interacting with a Palm Organizer using their finger because of the lack of precision which would accompany trying to use one's finger in the graffiti writing area. Accordingly, it is clear from the teaching of these references that they would teach away from any suggestion or motivation to use one's finger to interact with the device.

Applicants, therefore, submit that the suggestive power of 3Com® and 3Com®2 would lead away from its combination with a reference such as Derocher. In Derocher, column 1 teaches, in the Background of the Invention, that it applies to a hand-held computer and the like that has a touchpad that is used as a graphical input device to convey user inputs and control operations in the computing device. Such touchpads determine a position of the user's finger on the surface of the touchpad and can control the movement of a cursor as well as to control other aspects, such as scroll bars. Throughout the reference there are teachings of the sensors in the touchpad that are used to identify the position of the user's finger. For example, column 2, line 67 and column 5, line 23, provide several explicit examples of using one's finger. Furthermore, Figures 1 and 8 clearly show a finger being used on a touchpad. Accordingly, Applicants would respectfully submit that the suggestive power of Derocher in terms of being able to combine with a reference such as 3Com® or 3Com®2 is lacking in that the basic interactive function indifference between using a touchpad and using a stylus can be dramatic. Notably, Applicants would respectfully submit that the basic functional operation to enable the Palm V device to be

able to receive interaction via determining a position of a user's finger would require a complete redesign of the entire system. For example, the graffiti language and all of the interaction associated with being able to use such a language would have to be abandoned to enable the receipt of appropriate input using just one's finger. As can be noted in Chapter 2 of 3Com®2, the graffiti language requires fine positioning of the stylus such that the desired input can be properly interpreted. Such input cannot be accomplished in the small size of the graffiti writing area if a person is using his or her finger to try to input the graffiti data. As required by the MPEP, the teachings of the prior art as a whole for their suggestive power must be considered. Accordingly, because the basic principle of operation of the Palm V Organizer would have to be revised and modified in order to interact with the user via a user's finger as is taught in Derocher, Applicants respectfully submit that by a preponderance of the evidence one of skill in the art would not have sufficient motivation to combine 3Com® or 3Com®2 with Derocher.

Accordingly, Applicants respectfully submit that claims 5, 7, 20, 28 and 29 are patentable and in condition for allowance.

**Rejection of Claim 24 Under 35 U.S.C. §103(a)**

The Office Action rejects claim 24 under 35 U.S.C. §103(a) as being unpatentable over 3Com® in view of Derocher and Lenchik (U.S. Patent No. 6,822,640) ("Lenchik et al."). Applicants respectfully traverse this analysis and submit that based on the discussion above that one of skill in the art would not have sufficient motivation or suggestion to combine 3Com® with Derocher.

Applicants further submit that as discussed in the interview, one of skill in the art would also not have sufficient motivation to combine Lenchik et al. with either Derocher or 3Com®. Applicants note that Lenchik et al. teach a self-configuring multiple element portable electronic device. As is taught in the abstract and throughout the application as is shown in Figures 1-9 and

Figures 14-19, Lenchik et al. teach a self-configuring multiple element portable electronic device that wherein the function of the device automatically is modified based on the relative position of one panel 104 to another panel 106. Applicants respectfully submit that one of skill in the art would recognize that the display 120, shown in Figure 4, would also have multiple functions and its interactive features would be modified in the process of self-configuration as the relative position of the first electronic element to the second electronic element is changed. Applicants submit that one of skill in the art would then interpret this as a teaching away from using a two display computing device inasmuch as the single display 120 would already provide multiple different methods of input depending on that relative position. Accordingly, although Lenchik et al. teach a digit assistant that is capable of receiving calls, Applicants would respectfully submit that its overall suggestive power relative to its ability or its desirability of being combined with Derocher which teaches a touchpad and/or 3Com® with its dual input mechanism is lacking. When taken as a whole for their suggestive power, one of skill in the art would not have sufficient motivation to combine these references. Accordingly, for this reason, Applicants submit that Lenchik et al. should not be combined with 3Com® and/or Derocher and claim 24 is patentable and in condition for allowance.

### **CONCLUSION**

Having addressed all rejections and objections, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Deposit Account No. 50-3102** for any deficiency or overpayment.

Respectfully submitted,

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